


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Susumu Nakagawa
Serial No. : 09/878,581
Filed : June 11, 2001
For : IMAGE CONTENT AND ADVERTISEMENT DATA
PROVIDING METHOD, SYSTEM, AND APPARATUS (AS
AMENDED)
Examiner : Sheleheda, James R.
Art Unit : 2623
Confirmation No. : 2762

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted via
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Yedea H. Walker
(Name of person signing transmittal)

Signature
June 20, 2008
Date of Signature

RESTRICTION RESPONSE UNDER 35 U.S.C. § 121

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 20, 2008

Sir:

This election is filed in response to the Office Action dated May 22, 2008 (Paper No. 20080520). In the Office Action, the Examiner identified three (3) distinct inventions. The Examiner required the Applicant, under 35 U.S.C. § 121, to elect a single invention for prosecution. The three inventions identified by the Examiner are:

- I. Claims 1-9, 18, 20, 28 and 32-36, drawn to inserting an advertising image in image content prior to stream distribution, classified in class 725, subclass 36;
- II. Claims 10-17, 19, 22, 30 and 37, drawn to inserting advertising during reproduction of previously provided content, classified in class 725, subclass 142; and,
- III. Claims 21 and 29, drawn to an advertisement logging system, classified in class 725, subclass 115.

Pursuant to the Examiner's requirement, the Applicant provisionally elects group I, Claims 1-9, 18, 20, 28 and 32-36. Applicant reserves the right to file divisional applications.

Although a provisional election is made, the Examiner's restriction requirement is respectfully traversed. Applicant respectfully points out that 37 C.F.R. § 1.142 states that a restriction requirement "will normally be made before any action on the merits; however, it may be made anytime before final action" (emphasis added). Applicant respectfully points out that a final Office Action on claims 1-22 and 28-30 was first issued on June 29, 2006 (Paper No. 20060623) and another final Office Action was issued on July 24, 2007 (Paper No. 20070716). Therefore, Examiner's restriction requirement is made after final action and is therefore improper.

Additionally, MPEP § 811 states that the Examiner will consider whether there will be a serious burden if restriction is not required. Applicant respectfully points out that there can be no serious burden on the Examiner since all claims in the present case have already been examined by the Examiner in the Office Action dated November 27, 2007 (Paper No. 20071120). Additionally, in the Office Action dated May 20, 2005, the Examiner stated that

claims 1-22 and 28-30 are all drawn to a method and apparatus for providing image content and insertion of advertisements into the image content, classified in class 725, subclass 36.

Subsequent to the initial election, five Office Actions have been issued on the current claims including September 13, 2005, June 29, 2006 (final), January 4, 2007, July 24, 2007 (final), and November 27, 2007. Applicant respectfully submits that all claims and all art in the present application must have been searched in these five Office Actions two of which were final Office Actions. Applicant respectfully submits that there can be no serious burden placed on the Examiner since all claims have already been examined. Therefore, Applicant respectfully requests the Examiner withdraws the Restriction Requirement.

An earlier examination and favorable action on provisionally elected claims 1-9, 18, 20, 28 and 32-36 are respectfully requested. In addition, Applicant respectfully submits that the restriction requirement should be withdrawn and claims 1-22, 28-30 and 32-37 should be examined.

In the event this paper is not considered to be timely filed, Applicant hereby petition for an appropriate extension of time. The Commissioner is authorized to charge payment for any additional fees which may be required with respect to this paper to our Deposit Account No. 50-0320.

Respectfully submitted,

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Date: June 20, 2008